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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/523,168

01/27/2005

Sunao Kurimura

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EXAMINER

RAO, G NAGESH

ART UNIT

PAPER NUMBER

1792

MAIL DATE

DELIVERY MODE

11/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,168

Applicant(s)

KURIMURA ET AL.

Examiner

G. Nagesh Rao

Art Unit

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6,8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) 1,8 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3,5-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

1) Applicant's election without traverse of Group II claims 3 and 5-7 in the reply filed on 5/30/07 is acknowledged.

Claims 1 and 8-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/7/07.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2) Claims 3 and 5-6 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Shinma (US Patent No. 6,471,501).

Examiner wishes to point out that claims 3, 5-6 are directed to a set of apparatus claims and as such will be treated as apparatus claims. Ergo please see MPEP 2115 [R-2] for details regarding material worked upon by the apparatus does not limit the claim structure of the apparatus itself, since it is viewed as a recitation of intended use by the device.

Shinma 501 discloses a hot press-plate apparatus system that is capable of being used to work on a quartz crystal in order to help process the material. As can be seen in Figure 1 of Shinma 501, disclosed is a press-plate apparatus system comprised of a pair press-plates (23, 60) and heating blocks (22, 71, 72 i.e. anticipating plurality of heaters) attached to said press-plates, whereby the press plates (which have a protruding member) and the heating blocks are comprised of separate materials since they can be attached or removed off one another thus broadly reading on the phrase “constructed from a different material”, being that the two separate pieces are not one whole said material piece but two different material pieces whereby the press plate and heating block when combined together read on a pressing block thus reading on a heating mechanism in the pressing

blocks and with their being more than one heat source (22, 71, and 72) reading on plurality of heaters, followed by the upper press surface system is held on the main body of the pressing apparatus via a swinging mechanism (21, 24, and 25) which is used to help maintain the planarity of the product's surface worked upon which also includes as seen in Figures 8-9 curved surface (like that of "A" in Figure 1) whereby. Finally Shinma 501 discloses the use of a compressed air system which is utilized and reads on as being characterized in that the air pressure alone is used to generate the pressing force (See Col 3-13 Lines 1-68, in particular Col 4 Line 5-68, Col 6 Lines 44-55, Col 11 Lines 26-57, Col 12 Lines 9-39, and Figures 1-13).

However Shinma 501 does not explicitly teach a whole constructively figured device as claimed by applicant regarding the bearing block to the upper heater block based on a convex surface relating a radius of $R1$ to a radius of $R2$ such that $R2 > R1$.

Although in various embodiments such as the likes of Figures 8 and 9, there is shown the upper convex surface portion and it would be reasonable to presume that the $R2$ and $R1$ relation is the same as that of the claimed invention.

It would be obvious to one having ordinary skill in the art at the time of the present invention to understand and decipher the $R2$ and $R1$ relationship as denoted from Figures 8-9 and realize with comprehension of the alternative

embodiments of the prior art the full optimized and varying parameters set forth for the hot press apparatus system as taught in Shinma 501.

Response to Arguments

3) Applicant's arguments filed 9/19/07 have been fully considered but they are not persuasive.

Applicant's remarks regarding Shinma 501 are off point comparatively to what examiner stated in the preface to the rejection, which was that claims 3 and 5-6 are directed towards the apparatus system. Therefore the amendment to claim 3 recites a desired result to occur as a result of the apparatus system utilized, such as the language pertaining to the protrusion from the pressing member. The applicant's arguments pertaining to the desired purpose of Shinma 501 is moot, since examiner pointedly stated that the apparatus system was capable of performing said function and whether or not Shinma 501 states its purpose of use, is irrelevant to the fact that the product worked upon said system bears no weight to the claimed invention's physical parameters.

Examiner understands the intent and purpose of use for the claimed invention, but the product i.e. quartz crystal is not being claimed as part of the

apparatus but merely included as reference to recitation of intended use for pressing apparatus. Once again examiner points to MPEP 2115 [R-2] for guidance on the issues pertaining to "Material or Article worked upon does not limit apparatus claims". Examiner understands applicant's contention of Shinma 501 and its pertain usage in fabricating semiconductor devices is not the same as forming a twin in a quartz crystal, and that would be true in the case of a process claim, but the claims directed in this application are directed towards an apparatus. Therefore as denoted from the aforementioned rejection, Shinma 501 pretty much anticipates/obviates the currently claimed "apparatus" piece for piece.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to G. Nagesh Rao whose telephone number is (571) 272-2946. The examiner can normally be reached on 9AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571)272-1414. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GNR

/Robert Kunemund/

Robert Kunemund

Primary Examiner

TC 1700